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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) Q137-US7	
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	First Named Inventor David M. Skinlo		
	Art Unit 1745	Examiner Dah Wei D. Yuan	
<p>Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,491</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

David M. Skinlo

Serial No: 10/665,440

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY
CONSTRUCTION AND METHOD OF
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

Mail Stop AF
Commissioner for Patents
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Pre-Appeal Brief Request for Review

This communication is in response to the Office Action mailed on April 12, 2007 (the Office Action). Pending claims 66-79 are rejected under 35 USC 112 for allegedly omitting a critical feature. The Applicant submits that a clear legal error has been committed in rejecting claims 66-79 for omitting an allegedly critical feature.

REMARKS

A. The Pending Claims

Claim 66 is the only pending independent claim. Claim 66 is directed to a method of constructing an electric storage battery. The method includes positioning an electrode assembly in a case. The electrode assembly includes a first electrode strip and a second electrode strip wound around a pin so as to form a spiral roll. The pin is in electrical communication with the first electrode strip. The method also includes fastening a first end cap to the case such that the pin extends through the first end cap. The method also includes fastening a second end cap to the case such that a tab provides electrical communication between the second electrode strip and the second cap.

Rejection of Claims Under 35 USC §112

Claims 66-79 are rejected under 35 USC §112, first paragraph, as based on a disclosure which is not enabling. In particular, the Office Action argues that the “electrically conductive terminal pin being electrically insulated from the case’ is critical or essential to the practice of the invention, but not included in the claim, is not enabled by the disclosure.” Claim 66 does specify a pin in electrical communication with the first electrode strip and extending through the first end cap but does not specify that the pin is electrically insulated from the case. Accordingly, this rejection appears to be an argument that insulation of the pin from the case is essential to the operation of the claimed method.

In support of this rejection, the Office Action cites *In re Mayhew* which is discussed in MPEP §2164.08(c). MPEP §2164.08(c) addresses enablement when an allegedly critical feature is not claimed and is accordingly central to this rejection.

This rejection stems from an improper application of the law in MPEP §2164.08(c). The specification must teach that that insulation of the pin from the case is critical in order to support an enablement rejection under MPEP §2164.08(c). For instance, MPEP §2164.08(c) states that “(a) feature which is **taught as critical in a specification** and is not recited in the claims should result in a rejection of such claim under the enablement” (emphasis added). This same section of the MPEP also provides that this rejection “should be made **ONLY** when **the language of the specification** makes it clear that the limitation is critical for the invention to function as intended” (emphasis added). Accordingly, the specification must teach that the allegedly missing material is critical in order for this law to apply. Since the pending Office Action alleges that insulation of the pin from the case is critical, the specification must teach that that insulation of the pin from the case is critical in order for MPEP §2164.08(c) to be properly applied.

The Applicant’s specification provides an example where the pin is insulated from the case, however, the specification does not teach that insulation of the pin from the case is critical to the operation of the battery. For instance, neither the Abstract, the Summary, the Drawings, nor the Background state that insulation of the pin from the case is critical to the claimed method. **Further, the specification actually contemplates embodiments where the pin need not be insulated from the case.** For instance, the Summary of the invention provides that the “battery case itself generally functions as the other battery terminal” at page

3, line 19-20. The use of the term “generally” teaches that the case does not always function as the other battery terminal. If the case does not function as the other terminal, then it is not critical or essential for the pin to be electrically insulated from the case because the battery will not short when the pin is in electrical communication with the case. Since the specification does not teach that it is critical for the pin to be electrically insulated from the case, MPEP §2164.08(c) provides that rejection for lack of enablement is not supported. Accordingly, the claims need not specify that the pin is electrically insulated from the case and the rejection should be withdrawn.

Conclusion

The Applicant respectfully submits that legal error has been made by rejecting the pending claims for statutory double-patenting. For these reasons, allowance of claims 66-79 is respectfully requested.

Respectfully submitted



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